



30 JAN 2008

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In re Application of FISHER et al.
Application No.: 10/579,513
PCT No.: PCT/US04/38130
Int. Filing: 15 November 2004
Priority Date: 14 November 2003
Attorney Docket No.: KCK-002
For: DEEP WELL IRRIGATION PUMP

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: DECISION ON
:
: RENEWED PETITION
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: UNDER 37 CFR 1.47(a)
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: and PETITION
:
: UNDER 37 CFR 1.497(d)

This is a decision on applicant's Renewed Petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 27 November 2007, to accept the application without the signature of joint inventor, Abdilkadir Musa. Petitioner requests a one month extension of time, which is granted.

BACKGROUND

On 12 May 2006, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 28 February 2007, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration, in accordance with 37 CFR 1.497(a) and (b), was required.

On 24 May 2007, applicant filed a petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Abdilkadir Musa alleging that Mr. Musa refuses to sign the application.

On 27 August 2007 a decision was mailed dismissing the petition indicating, *inter alia*, that Petitioner had not provided sufficient evidence regarding the nonsigning inventor's refusal to sign the application papers.

On 27 November 2007, applicant filed the renewed petition with an executed declaration along with a petition under 37 CFR 1.497(d).

DISCUSSION

Applicant has now filed a declaration executed by the previous non signing inventor

MUSA. Thus, the petition under 37 CFR 1.47(a) is dismissed as Moot.

U.S. application number 10/579,513 is the national stage application of PCT application PCT/US04/38130. Applicants entering the national stage in the U.S. are required to file an oath or declaration of the inventor in accordance with 37 CFR 1.497(a) and (b). The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92bis. See 37 CFR 1.41(a)(4). Accordingly, an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.

The declarations submitted do not comply with 37 CFR 1.497(a) and (b) because the declarations do not identify all of the inventors identified in the international application PCT/US04/38130. Specifically, inventor Mohammed SWALEH is not named as an inventor on any of the declarations submitted in this application. Thus, the declarations are not executed by all the joint inventors.

Mohammed SWALEH is identified as an inventor in the published international application (PCT/US04/38130) but is not identified as an inventor on the declaration. Petitioner has not presented evidence from the International Bureau that Mr. SWALEH was removed as an inventor from the international application.

Applicant now attempts to delete inventor SWALEH with the submission of a petition under 37 CFR 1.497(d) to delete inventor¹. Petitioner provided the statement, signed by Mohammed SWALEH stating "I am the inventor of the subject matter of one or more claims originally presented in the International (PCT) Patent Application PCT/US04/38130. I am not an inventor of the subject matter of any of the claims entered by Preliminary Amendment on May 12, 2006." This is not a statement that the error in inventorship in the international application occurred without deceptive intent on his part. Inventor SWALEH was correctly named as an inventor in the PCT application. His statement does not satisfy item (1) of 37 CFR 1.497(d).

37 CFR 1.41(d) states, in pertinent part: "The *inventorship* of an international application entering the national stage under 35 U.S.C. 371 is that *inventorship set forth in the international application*, which includes any change effected under PCT Rule 92bis". (Emphasis added.) Since the inventors listed on the published international application were not identified on the declarations submitted in the national phase application on 24 May 2007 and 27 November 2007 as required by 37 CFR 1.41(d) and do not meet the requirements of 37 CFR 1.497(a) and (b), the

¹37 CFR 1.497(d) states, in part: If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement ...from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(I); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

declarations are not acceptable. A newly executed declaration is required, in compliance with 37 CFR 1.497(a) and (b).

After filing a declaration(s) in compliance with 37 CFR 1.497(a) and (b), in light of the preliminary amendments filed in this application, applicant may wish to pursue a petition under 37 CFR 1.48(b).

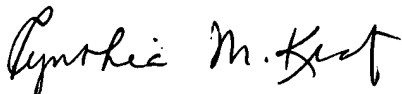
CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.497(d) to delete MOHAMMED SWALEH as inventor is hereby **DISMISSED**

For the reasons set forth above, the renewed petition under 37 CFR §1.47(a) is **DISMISSED AS MOOT**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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